UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,691	10/02/2003	Robert Keith Salsman	Salsman 032714.04C2	9767

27863 7590 12/15/2006

MCNAIR LAW FIRM, P.A.
P.O. BOX 10827
GREENVILLE, SC 29603-0827

EXAMINER	
WONG, STEVEN B	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED
DEC 1 5 2006
GROUP 3700

Application Number: 10/677,691
Filing Date: October 02, 2003
Appellant(s): SALSMAN, ROBERT KEITH

William Lee (Reg. #22,660)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 19, 2006 appealing from the Office action mailed January 23, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,954,263	Whelan et al.	05-1976
5,744,549	Lutz	04-1998
6,402,636	Chang	06-2002

5,890,976	Anderson	04-1999
5,984,808	Fleischer	11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 28 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whelan et al. (3,954,263) in view of Anderson (5,890,976), Chang (6,402,636), Fleischer (5,984,808) and Lutz (5,744,549). Regarding claim 28, Whelan et al. discloses a golf tee including a ball support surface wherein the tee is provided with a surface layer for protecting the tee. Note column 1, line 65 through column 2, line 4 and column 2, lines 43-45 stating that the surface layer is applied as a coating and may be made from various materials. Whelan also provides a central depression in the ball support surface. However, Whelan et al. lacks the teaching for the coating to be first formed as a layer before application to the tee.

Anderson discloses a golf tee construction including a surface layer applied to the shaft of the tee. Note column 2, line 59 through column 3, line 8 stating that it is well known in the art of golf tee to either apply the layer directly to the tee or first form the layer and then apply it to the shaft. Further, Anderson teaches that it is well known in the art of golf tees to apply the layer thereto using an adhesive (column 2, lines 65-67). It would have been obvious to one of ordinary skill in the art to form the coating of Whelan et al. first as a layer before application to the tee in order to provide an alternative method of manufacturing that is taught by Anderson as being substantially equivalent.

Chang, Fleischer and Lutz each disclose an article of golf equipment wherein polytetrafluoroethylene is included in order to reduce the friction between the article and a contacting surface. Each reference is relied upon as a specific teaching that it is old and well known in the art of golf equipment to merely include a layer of polytetrafluoroethylene on a surface in order to reduce its coefficient of friction. Attention is directed to column 1, lines 58-64, column 3,lines 20-30 and column 4, lines 6-10 of Chang, column 3, lines 11-20 of Lutz and column 3, lines1-22 and column 4, lines 5-13 of Fleischer. Each of these citations discloses the use of polytetrafluoroethylene in a golf environment where the polymer is utilized to reduce the frictional forces between the surfaces. Thus, given the suggestions of Chang, Fleischer and Lutz, it would have been obvious to one of ordinary skill in the art to provide the tee of Whelan et al. with a layer of polytetrafluoroethylene in order to reduce any frictional forces created between the tee and a contacting surface.

Regarding claim 30, the references to Chang, Fleischer and Lutz teach that the use of polytetrafluoroethylene is old and well known in the art of golf.

Regarding claim 31, the combination of Whelan in view of Anderson teaches a multi-component golf tee comprising a layer that is applied to the golf tee that conforms to the shape of the head of the tee.

Regarding claim 32, replacing the polyurethane coating on the tee of Whelan with a polytetrafluoroethylene layer will create a ball support surface consisting essentially of the polytetrafluoroethylene layer.

Regarding claim 33, Anderson teaches that it is well known in the art of golf tees to either apply a surface layer directly to the tee or to first form the layer and then apply it to the tee. It would have been obvious to one of ordinary skill in the art to form the coating of Whelan et al. first as a layer before application to the tee in order to provide an alternative method of manufacturing that is taught by Anderson as being substantially equivalent.

Regarding claim 34, Anderson states that it is well known in the art of golf tees to apply the layer to the tee using an adhesive.

Regarding claim 35, the surface layer that is first formed and then applied to the tee is seen as a shaped sheet that is adhered to the tee.

Regarding claim 36, the combination of Whelan et al. in view of Anderson teaches the claimed structure by providing a layer that is adhesively applied to the surface of the tee.

(10) Response to Argument

Re: There is No Anticipatory Prior Art

Regarding the appellant's argument that there is no anticipatory prior art, the rejection of the claimed invention is under 35 U.S.C. 103(a) where the claimed invention has been found to be obvious over the teachings of Whelan et al. in view of Anderson, Chang, Fleischer and Lutz.

Re: There is no Suggestion Nor Motivation to Combine the Primary Reference with the Secondary References

The appellant contends that the primary reference to Whelan is directed to a golf tee formed from grass seen and having a polyurethane outer coating and is not concerned with the reduction of friction between it and the golf ball. However, while this may true, the rejection is over the combination of Whelan in view of Anderson, Chang, Fleischer and Lutz. The reference to Whelan is relied upon merely for its teaching that it is well known in the art of golf tees to provide a polymeric outer coating for a golf tee in order to take advantage of that material's well known physical characteristics. Whelan states that the polymeric coating provides a protective coating for the tee. Further, Whelan states that varnish, hard rubber, plastics, wax and fiberglass also could be used as coatings for the tee. While Whelan is particularly directed to a golf tee having a core of growth material, another teaching of Whelan is that it is well known in the art of golf tees to provide a coating for the tee in order to take advantage of that material's well known physical characteristics. The references to Lutz, Chang and Fleischer are all directed towards golf equipment wherein a polymeric coating is applied to the surface of the equipment in order to take advantage of that material's well known physical characteristics. It is well settled that a new use for an old material is not patentable unless it produces new, unexpected and useful results. See *In re Bergen*, 49 USPQ 749 (CCPA 1941). Here, the application of polytetrafluoroethylene or an equivalent polymer on a golf tee does not produce any unexpected results. Clearly, one of ordinary skill in the art, given the teachings of Lutz, Chang and Fleischer, would fully expect the application of polytetrafluoroethylene to reduce the friction between the ball and the ball-supporting surface.

It is also well settled that the mere substitution of materials is unpatentable unless the known use of the old material was in art so far removed from new use as to be wholly non-analogous and not suggestive of new use. However, as shown by Lutz, Chang and Fleischer, the use of polytetrafluoroethylene is old and well known in the art of golf equipment in order to reduce the surface friction between the contact surfaces. See *In re Application of Henry B. Allen*, 33 USPQ 160 (CCPA 1937).

Regarding the appellant's argument that Whelan does not describe the polyurethane other than stating that it is coating, even if the polyurethane coating is made in a passing remark, such does not preclude that it is a teaching in the prior art that it is known in the art of golf tees to apply a polymeric coating to the surface of a golf tee in order to take advantage of that material's physical characteristics. Whelan advances this argument by providing a polymeric material and listing the advantageous and desirable properties of the material.

Re: The Whelan/Anderson Combination

Regarding the combination of Whelan with Anderson, the appellant argues that the examiner is incorrect in his statement that the combination of Whelan in view of Anderson teaches a layer that is applied to the golf tee that conforms to the shape of the head of the tee. The appellant argues that Anderson shows a layer that is not applied to the head of the tee. However, this is not persuasive as it is the combination of Whelan in view of Anderson, which teaches this structure. The combination of Whelan in view of Anderson teaches a layer that is applied to the golf tee that conforms to the shape of the head of the tee. Whelan teaches that it is well known in the art of golf tees to provide coatings of various materials (note column 1, line 65 through column 2, line 4 and column 2, lines 43-45). The reference to Anderson is relied upon merely for its teaching that it is old and well known in the art of golf tees to provide a surface layer to the shaft of a tee where the layer is either applied directly to the tee or the layer is formed first and then applied to the shaft.

Re: Claim 32

Regarding claim 32, this claim does not specifically require a cover or a layer and only recites "a ball support surface consisting essentially of a polymeric material". This limitation is met by the combination of Whelan in view of Anderson as the combination presents a golf tee support surface of a polymeric material such as polytetrafluoroethylene.

Re: The Whelan/Chang Combination

Regarding the references Whelan and Chang, the appellant argues that the friction reducing material applied to the face of a golf club is not suggestive of the instant invention as the friction reducing material is applied to the golf club face to reduce the tendency to hook or slice. The Chang patent teaches the reduction of frictional forces with a ball by introducing polytetrafluoroethylene. The Chang patent provides the polytetrafluoroethylene material on the face of a golf club head in order to reduce any frictional forces between the contact surfaces. Thus, the Chang patent teaches that it is old and well known in the art of golf to apply polytetrafluoroethylene to the ball contacting surfaces in order to reduce the frictional effects created between the surfaces.

Re: The Whelan/Fleischer Combination

Regarding the references Whelan and Fleischer, the appellant argues that the strip of material used by Fleischer is wrapped around the golf ball and is intended to keep the ball on a straight path. It should be noted that this reference is especially pertinent since it concerns a golf tee and is directed to reducing the frictional effects between the tee and the golf ball. Fleischer particularly states that the polytetrafluoroethylene-coated strip reduces frictional forces. Note the Abstract. Thus, Fleischer teaches that it is old and well known in the art of golf and particularly golf tees to use polytetrafluoroethylene between ball contacting surfaces in order to reduce the frictional effects created between the surfaces.

Re: The Whelan/Lutz Combination

Regarding the remarks directed to the references of Whelan and Lutz, the appellant argues that the coating of fluorinated polyurethane applied to the golf ball of Lutz is for abrasion resistance and that no teaching is present to apply the polyurethane coating of Lutz to a golf tee. Lutz teaches a fluorinated polyurethane that is applied to a golf ball. The polyurethane has various desirable properties such as enhanced abrasion, impact and weathering resistance and decrease in frictional resistance. Note the Abstract of Lutz. The reference to Whelan teaches that it is desirable for his polyurethane coating to be hard enough such that the "decomposing process will not take place until the growth tee is either broken or is cut with a lawn mower". Whelan also suggests that other coatings such as varnish, hard rubber, plastics, wax, fibreglass or the like can be used (column 2, lines 43-45). Thus, Whelan provides a suggestion to one of ordinary skill in the art to substitute the polyurethane coating with other plastic materials that would also provide a hard protective coating for the golf tee. The enhanced abrasion and impact and weathering resistance of the fluorinated polyurethane of Lutz would clearly make the material desirable as a coating material for the golf tee of Whelan. Thus, it would have been obvious to one of ordinary skill in the art to replace the polyurethane coating of Whelan with the fluorinated polyurethane of Lutz in order to provide an alternative coating material that also prevents premature decomposing of the golf tee. By providing the golf tee of Whelan with the fluorinated polyurethane coating of Lutz, the golf tee will obviously possess a friction-reducing layer.

Further, it is the combination of references taken as a whole, which are suggestive of the instant invention. The references to Lutz, Fleischer and Chang are cited as a collective teaching that it is well known in the art of golf to apply polytetrafluoroethylene to the surface of various golf equipment in order to take advantage of that material's well known physical characteristics (I.e. reduced coefficient of friction, enhanced weathering properties, impact resistance). While no mention is made of a ball-supporting surface in the references of Lutz and Chang, the rejection is over the combination of Whelan in view of these references. Whelan teaches the use of a coating on a ball support surface. The references to Lutz and Chang teach that fluorinated polyurethane and polytetrafluoroethylene are known in the art of golf for their specific physical properties. It would have been obvious to one of ordinary skill in the art to apply a coating of fluorinated polyurethane or polytetrafluoroethylene to a golf tee in order to take advantage of the material's well-known physical properties. Regarding the reference to Fleischer, this reference teaches that it is known in the art of golf tees to utilize polytetrafluoroethylene in order to reduce the frictional effects between the support surface and the golf ball. It would have been obvious to one of ordinary skill in the art to provide a golf tee with a coating of polytetrafluoroethylene in order to take advantage of the material's well-known physical properties.

Attention is again directed to the decisions cited above. The decisions demonstrate that it is well settled that new, unexpected and useful results must be shown in order to define a patentable new use for an old material or that the new use of the old material must be in art so far removed from the old use as to be wholly non-analogous and not suggestive of the new use. However, as shown by the teachings of Lutz, Fleischer and Chang the instant invention fails to satisfy either criterion. First, the use of polytetrafluoroethylene or an equivalent thereof on a golf tee in order to produce reduced frictional effects does not produce a new and unexpected result. One of ordinary skill in the art given the teachings of Lutz, Fleischer and Chang would clearly expect the application of polytetrafluoroethylene on a golf tee to reduce the frictional effects between contact surfaces. Further, it should be again noted that Fleischer is particularly pertinent as it specifically teaches that it is old and well known in the art of golf tees specifically that the application of polytetrafluoroethylene to a surface of the golf tee reduces its frictional forces.

Secondly, the references to Lutz, Fleischer and Chang are all related to the instant invention and that of Whelan and Anderson in that they are all related to golf equipment. Again, Fleischer should gain special note as it is particularly directed to a golf tee environment. Thus, the prior art is not so far removed from the new use that they could be considered non-analogous.

Re: Conclusion

The appellant argues:

1) That none of the references show nor suggest a method for increasing the distance that a golf ball is driven. However, this argument should not be persuasive as it is the references to Lutz, Chang and Fleischer which teach that it is well known in the art of golf equipment to apply a friction reducing material to the surface of the golf equipment in order to reduce the frictional effects between the contact surfaces. To apply the friction reducing material to the surface of a golf tee would create a method for increasing the distance that a golf ball is driven by reducing the frictional resistance between the contact surfaces. Further, it should be noted that the substitution of the polyurethane coating of Whelan with the fluorinated polyurethane coating of Lutz is suggested by other desirable properties of the fluorinated polyurethane such as enhanced abrasion and weather resistance. It would have also been obvious to one of ordinary skill in the art to replace the polyurethane coating of Whelan with the fluorinated polyurethane coating of Lutz in order to take advantage of the fluorinated polyurethane's physical characteristics such as enhanced abrasion and weather resistance.

2) That none of the references show nor suggest the claim limitation of a polymer surface layer formed from friction reducing material that is applied to a golf tee ball support. However, this argument should not be persuasive as the reference to Whelan teaches that it is known in the art of golf tees to apply a polymer surface layer to a golf tee. The references to Lutz, Chang and Fleischer teach that it is well known in the art of golf equipment to use polymers such as polytetrafluoroethylene in order to take advantage of their well-known physical characteristics. Regarding claim 32, Whelan teaches a ball support surface that consists essentially of a polymeric material.

3) That none of the references show nor suggest the limitation of forming a conforming or shaped cover layer for a ball support surface where the cover layer is made from a friction-reducing polymer. However, this argument should not be persuasive as the reference to Whelan teaches that it is known in the art of golf tees to apply a polymer surface layer to a golf tee. The references to Lutz, Chang and Fleischer teach that it is well known in the art of golf equipment to use polymers such as polytetrafluoroethylene in order to take advantage of its well-known physical characteristics.

4) That none of the references show nor suggest a shaped friction reducing cover for a golf tee or support surface where an adhesive is on one side of the cover. However, this argument should not be persuasive as the reference to Anderson states that it is well known in the art of golf tees to apply a layer to the tee using an adhesive. The references to Lutz, Chang and Fleischer teach that it is well known in the art of golf equipment to use polymers such as polytetrafluoroethylene in order to take advantage of its well-known physical characteristics.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Steven Wong
Primary Examiner
AU3711

Conferees:

Mark Graham

Sebastiano Passaniti

Sebastiano Passaniti
Primary Examiner